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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/863,453      | 05/24/2001  | Hisashi Shiba        | NE220-US            | 9835             |

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| EXAMINER |
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CRAIG, DWIN M

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| ART UNIT | PAPER NUMBER |
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2123

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/863,453

Applicant(s)

SHIBA, HISASHI

Examiner

Dwin M Craig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2 & 4.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

1. **Claims 1-13** have been presented for Examination.

### Specification

2. The abstract of the disclosure is objected to because the number of words exceeds 150.

Correction is required. See MPEP § 608.01(b), and ...

#### **6.02 Content of Specification**

(j) Abstract of the Disclosure: A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims.

### Improper Incorporation by Reference

3. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

**3.1** *Specifically*, the Examiner notes that the Applicant is attempting to incorporate by reference a Japanese Patent Application on pages 41 and 42 of the specification. *The Examiner notes that this is Applicant's Japanese Patent Application for which priority is being claimed, and the Examiner is confused as to why the Applicant would require incorporation of the foreign parent of the U.S. Application into the U.S. Application. It would appear that there is a*

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*difference between the claimed subject matter enabled by the Foreign Application and the claimed subject matter in the U.S. Application. Clarification is required as to why that enabling subject matter was not included in the U.S. Application.*

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**4. Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Niijima et al.**

**U.S. Patent 5,640,098.**

**4.1** As regards independent **Claims 1-13** the *Niijima et al.* reference teaches CAD data that is translated to a fault detection format for an I.C. mask (**Figures 3 & 8, Col. 1 Lines 39-45, Col. 2 Lines 53-64, Col. 5 Lines 43-62**).

**5. Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanaka U.S.**

**Patent 4,996,434.**

**5.1** As regards **Claims 1-13** the *Tanaka* reference teaches Cad data that is translated to a fault detection format for an I.C. mask (**Figures 2-4, 12, Col. 2 Lines 25-35, Col. 14 Lines 22-68, Col. 15 Lines 1-20**).

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. **Claims 1-13** are rejected under 35 U.S.C. 102(e) as being anticipated by **Aleshin et al. U.S. Patent 6,263,299**.

6.1 As regards independent **Claims 1-13** the *Alshin et al.* reference teaches, converting CAD data for an I.C. mask design to the data format for an error detection device (**Figures 4 & 8, Col. 8 Lines 35-38, Col. 19 Lines 1-11**), and vertex (**Col. 9 Lines 11-20 & Figure 5**).

7. **Claims 1-13** are rejected under 35 U.S.C. 102(e) as being anticipated by **Bula et al. U.S. Patent 6,704,695**.

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7.1 As regards independent **Claims 1-13** the *Bula et al.* reference teaches, converting CAD data for an I.C. mask design to the data format for an error detection device (**Figures 1-4 Col. 2 Lines 39-50**).

8. **Claims 1-13** are rejected under 35 U.S.C. 102(e) as being anticipated by **Luo et al. U.S. Patent 6,324,673**.

8.1 As regards independent **Claims 1-13** the *Luo et al.* reference teaches, converting CAD data for an I.C. mask design to the data format for an error detection device (**Figure 4-9, 14-16, Col. 7 Lines 23-31**) and different regions (**Col. 12 Lines 23-55**).

### **Conclusion**

9. **Claims 1-13** have been presented for Examination. **Claims 1-13** have been examined and rejected. This Office Action is **Non-Final**.

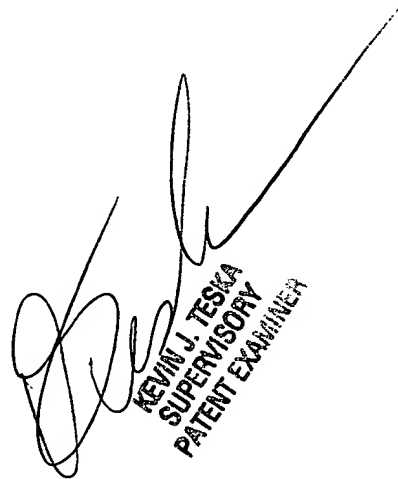
9.1 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwin M Craig whose telephone number is (571) 272-3710. The examiner can normally be reached on 10:00 - 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Teska can be reached on (571)272-3716. The fax phone number for the organization where this application or proceeding is assigned is 703-308-1396.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DMC



KEVIN J. TESKA  
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